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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/853,507	05/10/2001	Richard E. Weller	E-1507 CON	7165

7590

02/14/2002

Intellectual Property Services  
Battelle Memorial Institute  
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Richland, WA 99352

EXAMINER
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JONES, DAMERON LEVEST

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 02/14/2002

X

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/853,507

Applicant(s)

WELLER ET AL.

Examiner

D. L. Jones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-27 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.                      6) ☐ Other: \_\_\_\_\_.

### CLARIFICATION OF RECORD

1. The previous Office Action is VACATED in light of the restriction requirement as set forth below.

### RESTRICTION INTO GROUPS

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-3 and 18-27, drawn to a radioisotope carrier comprising a biodegradable polysaccharide polymer, classified in class ~~422~~<sup>424</sup>, subclass 1.73.
  - II. Claims 1-3 and 18-27, drawn to a radioisotope carrier comprising a biodegradable polypeptide, classified in class 424, subclass 1.69.
  - III. Claims 1, 2, 4, and 18-27, drawn to a radioisotope carrier comprising a cellulose polymer, classified in class 424, subclass 1.73.
  - IV. Claims 1, 22, and 18-~~227~~<sup>27</sup>, drawn to a radioisotope carrier comprising an agar polymer, classified in class 424, subclass 1.73.
  - V. Claims 1, 2, and 18-27, drawn to a radioisotope carrier comprising a gelatin polymer, classified in class 424, subclass 1.69.
  - VI. Claims 1, 2, and 18-27, drawn to a radioisotope carrier comprising a chitosan polymer, classified in class 424, subclass 1.73.
  - VII. Claims 1, 2, and 18-27, drawn to a radioisotope carrier comprising an alginate gel polymer, classified in class 424, subclass 1.73.

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VIII. Claims 1, 2, and 5-27, drawn to a radioisotope carrier comprising a gelling copolymer comprising methacrylamide, classified in class 424, subclass 1.37.

IX. Claims 1, 2, and 18-27, drawn to a radioisotope carrier comprising a polymer not appearing in Groups I-VIII above, classified in class 424, subclass 1.11.

**Note:** Claims appearing in more than one group will be examined only to the extent that they read upon the elected invention.

3. The inventions are distinct, each from the other because of the following reasons:

Inventions I-IX are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated since examination of one group having a designated polymer would neither anticipate nor render the other groups obvious.

**Note:** It should be noted that restriction, as in the instant invention, is proper since under the statute an application may be restricted when more than one invention is able to support a separate patent and the invention are either independent OR distinct from one another. Furthermore, it should be noted that there is a serious burden on the Examiner to search the instant invention since it reads on a multiplicity of patentably distinct polymers.

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4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

#### **ELECTION OF SPECIES**

5. Claims 1-27 are generic to a plurality of disclosed patentably distinct species comprising a stimulus sensitive gel. In particular, independent claim 1 reads on any possible stimulus sensitive gelling polymer and an insoluble or confine radioisotope. *Thus, Applicant is respectfully requested to elected a single species from the elected group above for prosecution (e.g., Example 1, Example 4, etc.).* Applicant is required under 35 U.S.C. 121 to **elect a single disclosed species**, even though this requirement is traversed.

6. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

7. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).


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8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (703) 308-4640. The examiner can normally be reached on Mon.-Fri. (alternate Mon.), 6:45 a.m. - 4:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose' Dees can be reached on (703) 308- 4628. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

  
D. L. Jones  
Primary Examiner  
Art Unit 1616

February 11, 2002